

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the following discussion is respectfully requested.

Claims 1 and 3-16 are pending.

In the outstanding Office Action, Claims 1, 3, 5, 7-9, and 14-16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kobayashi et al. (WO 03/007752, hereinafter “Kobayashi”).

Regarding Applicants’ claim to foreign priority, the Office Action again states that “Japan 2004-008099 does not appear to be related to application 10/560,044 therefore it will not receive the foreign priority date 1/15/2004” and gives the reasoning that “because without a foreign translation it appears based on the drawings of 2004-008099 is a species of the application.” Applicants respectfully request clarification of the position taken in the Office Action. Specifically, it is unclear how JP 2004-008099 can be “a species of the application” and still “not appear to be related to” the present application? Further, if JP 2004-008099 provides support for a species of the present application, then a priority claim to JP 2004-008099 is proper and should be acknowledged.

Additionally, it is noted that Applicants are not presently relying on JP 2004-008099 for an effective filing date for the current set of claims, but are claiming foreign priority to JP 2004-008099 as providing support for the invention described in the present application. Accordingly, Applicants again respectfully submit that the foreign priority claim to JP 2004-008099 made at the time of filing was proper and Applicants do not waive that claim to priority.

In response to the rejection under 35 U.S.C. § 103(a), Applicants respectfully request reconsideration of this rejection and traverse this rejection, as discussed below.

Claim 1 recites:

A hair holder, comprising:

a flat tube having a sheet which forms a first side and a sheet which forms a second side to allow a hair bundle to be inserted from an opening at one end of the tube toward an opening at an other end thereof such that, when the hair holder is rolled up, the sheet which forms the first side is on an outside of the tube,

the sheet which forms the first side of the tube is more extensible in a length direction of the tube than the sheet which forms the second side of the tube,

the sheet which forms the second side of the tube has a Taber stiffness of 0.4 mNm or higher, and

the sheet which forms the first side has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N.

It is respectfully submitted that the cited reference does not disclose or suggest every feature recited in Claim 1.

Kobayashi describes a hairdressing tool formed of two rectangular sheets. The two rectangular sheets described in Kobayashi include sheet 223A that has longitudinal extensibility and sheet 223B that has substantially no longitudinal extensibility.¹ Accordingly, the two sheets 223A and 223B form a tube 212 of a hair holder 200 having substantially no extensibility as a whole.² Further, Kobayashi describes alternative embodiments and states that, as long as the tube has substantially no extensibility as a whole, part of the sheet(s) forming the tube may have extensibility.³

The Office Action, in the first paragraph on page 4, again acknowledges that Kobayashi does not disclose “the first side of the sheet having at least 15 times higher of an extension under a load of 5N as of the second sheet.” Instead, the Office Action asserts that

¹ See Kobayashi, at paragraph [0132] of U.S. Publication No. 2004/0231689, which is the national stage application of WO 03/007752.

² See Kobayashi, at paragraph [0132].

³ See Kobayashi, at paragraph [0133].

such a ratio of extensibility between the first and second sheet would have been obvious to one having ordinary skill in the art at the time of the invention “since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.”

However, is it respectfully submitted that a person of ordinary skill in the art reading Kobayashi would not have found discovering the claimed range to be routine as the range was an unexpected result obtained by the inventors of the present application, as discussed below.

In support of the position taken by the Office Action, in section 7 on page 5, the Office Action states that “Kobayashi discloses that the tube can be rolled up smoothly with whichever of the sheets 223A and 223B located on the inside.” Applicants respectfully traverse this position. As shown in the attached Declaration, a tube for a hair holder that has an extensibility ratio of 13 (Comparative Example 3) had an unacceptable curl finish. Further, a tube for a hair holder that has an extensibility ratio of 15 (Example 3) had an acceptable curl finish. Thus, contrary to the statement made in Kobayashi and relied on by the Office Action, having an extensibility ratio of 15 or greater provides the unexpected result of having an acceptable curl finish.

Accordingly, Applicants respectfully traverse the position taken in the Office Action that the claimed extensibility ratio would have been obvious to one having ordinary skill in the art at the time of the invention. Instead, as shown in the attached Declaration and as discussed above, the claimed extensibility ratio provided unexpected results that would not have been obvious based on the description of Kobayashi.

Therefore, it is respectfully submitted that Kobayashi does not disclose or suggest every feature recited in Claim 1. Thus, it is respectfully requested that the rejection of Claim 1, and all claims dependent thereon, as unpatentable over Kobayashi be withdrawn.

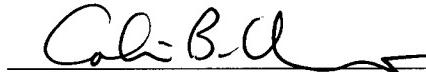
Independent Claim 8 recites, *inter alia*, a method of treating hair, including employing a hair holder in which “the sheet which forms the second side of the tube has a Taber stiffness of 0.4 mNm or higher, and the sheet which forms the first side has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N... and rolling up the tube having the hair therein with the first side thereof facing out.”

Therefore, in view of the discussion of Kobayashi with respect to Claim 1, it is respectfully submitted that Kobayashi does not disclose or suggest every feature recited in Claim 8. Thus, it is respectfully requested that the rejection of Claim 8, and all claims dependent thereon, as unpatentable over Kobayashi be withdrawn.

Consequently, in view of the present response, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

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